# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/753,507 | 01/03/2001 | Neil P. Hudd | 12385-002001 | 3101 |

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| 26161 7590 06/29/2004 | | EXAMINER | |
| FISH & RICHARDSON PC | | HAYES, JOHN W | |
| 225 FRANKLIN ST | | | |
| BOSTON, MA 02110 | | ART UNIT | PAPER NUMBER |
| | | 3621 | |

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/753,507 | HUDD ET AL. |
| | Examiner | Art Unit |
| | John W Hayes | 3621 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)☒ Responsive to communication(s) filed on <u>03 January 2001</u>.
2a)☐ This action is **FINAL**.     2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)☒ Claim(s) <u>1-33</u> is/are pending in the application.
  4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-33</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on <u>03 January 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.
  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  a)☐ All   b)☐ Some *  c)☐ None of:
    1.☐ Certified copies of the priority documents have been received.
    2.☐ Certified copies of the priority documents have been received in Application No. _____.
    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).
  * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**
1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 12-15, 17-19 and 30-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Ortiz, U.S. Patent Application Publication No. US 2002/0077974 A1.

As per **Claims 12 and 17**, Ortiz discloses a method comprising:

- exchanging information with a user at an electronic device, the information being about a proposed credit or debit transaction, the information being exchanged through a user interface that includes an information display and an information input device, the electronic device comprising a publicly-distributed, stand-alone interactive hand-held device running a publicly available operating system such as a PDA (Figures 1-3; 0041; 0047; 0048; 0051; 0056; 0063; 0096);

- communicating information that is input by a user from the electronic device to a server through a communication link that is at least partially wireless (0016; 0018; 0022; 0046; 0056; 0065-0069; 0083; 0095);

- the display of information to the user on the information display and the receipt of information from the user through the information input device being controlled through the communication link by an application running on the server (Figures 1-3; 0056; 0083; 0096), and

- at the server, using the information input by the user and communicated to the server to effect the transaction (0095; 0096).

As per **Claim 13**, Ortiz further disclose wherein the electronic devices comprise off-the-shelf stand-alone hand-held devices such as a PDA (0048).

As per **Claims 14 and 18**, Ortiz further discloses wherein at least one of the links uses a TCP/IP protocol (0073).

As per **Claims 15 and 19**, Ortiz further discloses wherein the information about the debit or credit transaction is entered interactively through user interfaces of the devices (0041).

As per **Claim 30**, Ortiz discloses a method comprising:

- exchanging information at hand-held devices, the information being about proposed credit or debit transactions (Figures 1-3; 0041; 0047; 0048; 0051; 0056; 0063; 0096),

- at a server, receiving information about the transactions from the devices through communication links that are at least in part wireless (0016; 0018; 0022; 0046; 0056; 0065-0069; 0083; 0095),

- running an application on the server, the application being configured to effect credit and debit transactions using the received information received from the hand-held devices (0067-0068; 0095; 0096),

- effecting credit and debit transactions using the application and the received information (0095, 0096).

- running other applications at the server and controlling user interfaces at the hand-held devices from the server to provide functions of the other applications, the other applications not being ones that effect credit or debit transaction such as administrative software that controls access to the WLAN and its resources such as printers and disk drives and provides resources to computers and/or wireless hand held devices within the WLAN; and applications that respond to commands from a client within a

client/server based network with wireless capabilities to support application such as printing and an electronic mailbox to support a customer e-mail account (0067-0068).

As per **Claim 31**, Ortiz discloses an apparatus comprising:

- an interactive handheld device (Figures 1-4; 0048),

- a reader for reading debit or credit cards to be used in debit or credit transactions entered on the hand-held device (Figures 3-4; 0043), and

- a printer adapted to print receipts for debit or credit transactions (Figures 4-5; 0065);

- the device, the reader, and the printer having a short-range wireless communication capability to carry information about the credit or debit transactions between the device and the reader and between the device and printer (Figures 2-5; 0045; 0052; 0065).

As per **Claim 32**, Ortiz discloses a method comprising:

- running a client application on a mobile electronic device and a server application on a central server, the server application controlling the client application to provide financial transaction authorization services with respect to transactions occurring at the mobile electronic device (0041; 0043; 0044; 0045; 0047; 0048; 0056; 0064; 0066-0067; 0094-0096), and

- providing additional non-financial transaction services by additional client applications at the mobile electronic device, the additional client applications being under the control of additional server applications running on the server (0007; 0067-0068).

### Claim Rejections - 35 USC § 103

3.  The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ortiz, U.S. Patent

Application Publication No. US 2002/0077974 A1 in view of Sarradin, U.S. Patent No. 5,387,784.


        As per **Claims 1 and 6-7**, Ortiz discloses a method comprising

        -  opening a communication session between an electronic device and a server, the

communication sessions being carried on communication links each of which is at least partially wireless

(Figure 5; 0018; 0019; 0039; 0046; 0048; 0065; 0066),

        - sending from the devices to the server information associated with proposed debit or credit

transactions (0045; 0056; 0065; 0095),

        - completing the transactions using an application running on the server (0095),

        Ortiz further discloses using a Cellular Digital Packet Data network and TCP/IP based technology

(0073) as well as other wireless communication technologies which can be used to maintain a

communications session.  Ortiz, however, does not explicitly disclose maintaining the communications

sessions in existence during inactive periods when information about another debit or credit transaction is

not waiting to be sent from one or more of the devices to the server, and, after the inactive periods, using

the maintained communication sessions to send, from the devices to the server, information associated

with other proposed debit or credit transactions. These wireless technologies disclosed by Ortiz also have

the capability to maintain simultaneous communication sessions with multiple electronic devices,

however, Ortiz does not explicitly disclose simultaneous communication sessions between electronic

devices.  Sarradin discloses portable payment terminals and networks for such terminals and further

discloses simultaneous communication sessions with multiple electronic devices or payment terminals

(Col. 4, lines 45-50).  Sarradin further discloses an on-line mode in which communications with the

terminals is maintained (Col. 2, lines 45-57; Col. 3, lines 25-28 and 57-67).  Thus, Sarradin discloses

maintaining an on-line communication sessions with multiple payment terminals which certainly would be

used to carry out proposed credit transactions at any point in time; in rapid succession or after a period of

inactivity.  It would have been obvious to one of ordinary skill in the art at the time of applicant's invention

to modify the method of Ortiz and include the ability to maintain simultaneous communication sessions

with multiple payment terminals as taught by Sarradin. Sarradin provides motivation by indicating that

this on-line mode is very suited to private networks of the type which are installed in places of sale known

as "hypermarkets" and in restaurants providing a suggestion that many transactions may be carried out in

a very short period of time (Col. 3, lines 25-28).

Furthermore, applicant admits that maintaining an open communication session with multiple

remote devices is known in the art by using any available software (See applicant's specification, page

15, lines 10-15). Thus, it further would have been obvious to one having ordinary skill in the art to modify

the method of Ortiz and provide open communication sessions with multiple devices using available

software.

As per **Claims 2 and 8**, Ortiz further disclose wherein the electronic devices comprise off-the-

shelf stand-alone hand-held devices such as a PDA (0048).

As per **Claims 3 and 9**, Ortiz further discloses wherein at least one of the links uses a TCP/IP

protocol (0073).

As per **Claims 4 and 10**, Ortiz further discloses wherein the information about the debit or credit

transaction is entered interactively through user interfaces of the devices (0041).

As per **Claims 5 and 11**, Ortiz fails to disclose discarding information about the transaction at

each of the devices when the transactions have been completed. Examiner takes Official Notice,

however, that deleting transaction information from devices after the transaction has been completed is

well known in the art. One would have been motivated to discard the transaction information to prevent

the information from being stolen and misused thereby preventing fraud.

5.   Claims 16, 20 and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ortiz, U.S.

Patent Application Publication No. US 2002/0077974 A1.

As per **Claims 16 and 20**, Ortiz fails to disclose discarding information about the transaction at each of the devices when the transactions have been completed. Examiner takes Official Notice, however, that deleting transaction information from devices after the transaction has been completed is well known in the art. One would have been motivated to discard the transaction information to prevent the information from being stolen and misused thereby preventing fraud.

As per **Claim 25**, Ortiz discloses a method comprising:

- exchanging information at hand-held devices, the information being about proposed credit or debit transactions (Figures 1-3; 0041; 0047; 0048; 0051; 0056; 0063; 0096),

- at a server, receiving information about the transactions from the devices through communication links that are at least in part wireless (0016; 0018; 0022; 0046; 0056; 0065-0069; 0083; 0095),

- running an application on the server, the application being configured to effect credit and debit transactions using the received information received from the hand-held devices (0067-0068; 0095; 0096,

- effecting credit and debit transactions using the application and the received information (0095, 0096).

Ortiz further discloses that the server may run administrative software that controls access to the WLAN and its resources such as printers and disk drives and provides resources to computers and/or wireless hand held devices within the WLAN. The server may also be configured as a computer or program that responds to commands from a client within a client/server based network with wireless capabilities. Potential resources that may be available include a printing station and an electronic mailbox to support a customer e-mail account (0067-0068). Thus, Ortiz discloses applications that support other functions not related to credit card processing. Ortiz fails to specifically disclose updating an application on the server without updating any application related to the processing of credit and debit transactions on the devices and after updating, continuing to effect credit and debit transactions. Examiner takes Official Notice that it would have been obvious to one of ordinary skill in the art at the time of applicant's

invention to modify the method of Ortiz and allow for the ability to update the application (for example,

updating the application with respect to the electronic mailbox or e-mail accounts) without affecting any

other application related to the processing of credit card transactions.  This ability was generally well

known in the art at the time of applicant's invention.  For example, network servers that serve a plurality of

client devices are known for providing a plurality of different types of applications such as e-mail account

processing, word processing functions, database functions as well as others.  It certainly would have

been obvious to one having ordinary skill in the art that any one of these applications may be updated

without affecting any applications related to other types of processing.  This ability generally isolates

processing functions within the server to allow flexibility in updating, adding or removing certain

applications without affecting other applications.

As per **Claim 26**, Ortiz further disclose wherein the electronic devices comprise off-the-shelf

stand-alone hand-held devices such as a PDA (0048).


As per **Claim 27**, Ortiz further discloses wherein at least one of the links uses a TCP/IP protocol

(0073).


As per **Claim 28**, Ortiz further discloses wherein the information about the debit or credit

transaction is entered interactively through user interfaces of the devices (0041).


As per **Claim 29**, Ortiz fails to disclose discarding information about the transaction at each of the

devices when the transactions have been completed.  Examiner takes Official Notice, however, that

deleting transaction information from devices after the transaction has been completed is well known in

the art.  One would have been motivated to discard the transaction information to prevent the information

from being stolen and misused thereby preventing fraud.

6.    Claims 21-24 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ortiz, U.S.

Patent Application Publication No. US 2002/0077974 A1 in view of Ware, U.S. Patent No. 4,707,592.


         As per **Claims 21 and 33**, Ortiz discloses a method comprising:

         - exchanging information at an electronic device, the information being about proposed credit or

debit transactions of customers, the information including confidential identification information about

accounts of the customers (Figures 1-3; 0041; 0047; 0051; 0056; 0063; 0095-0096);

         - communicating information about the transactions, including the confidential identification

information, from the device to a server over a communication link that is at least partially wireless (0016;

0018; 0022; 0046; 0056; 0065-0069; 0083; 0095),

         - effecting the transactions from the server (0095; 0096), and

         Ortiz further discloses that the confidential information such as the customers credit card data is

stored in memory (0095) such as RAM (0038) which is generally known as temporary storage of data in

volatile memory that losses its data when the power is shut off.  Ortiz, however, fails to specifically

disclose discarding the confidential identification information at the device after the transactions have

been effected so that the confidential identification information is not retained on the electronic device

when it is powered down.  Ware discloses a credit card transaction processing system including a device

for reading card data and temporarily storing this data in a memory in order to carry out the transaction

(Figure 1A; Col. 10, lines 27-40) and further discloses that, after completion of the transaction, all

transaction data are erased to insure that it is kept secret (Col. 10, lines 45-53).  It would have been

obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ortiz

and ensure that all stored transaction data is erased or otherwise discarded after completion of the

transaction to insure that this data is kept secure and thereby reducing the risk of fraud.


         As per **Claim 22**, Ortiz further disclose wherein the electronic devices comprise off-the-shelf

stand-alone hand-held devices such as a PDA (0048).

As per **Claim 23**, Ortiz further discloses wherein at least one of the links uses a TCP/IP protocol (0073).


As per **Claim 24**, Ortiz further discloses wherein the information about the debit or credit transaction is entered interactively through user interfaces of the devices (0041).


## *Conclusion*

7. **Examiner's Note**: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.


8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

• Tognazzini discloses a portable credit card authorizer for authorizing card purchases having a card reader for reading a card authorization code (account number) and a wireless transceiver for transmitting the card authorization code to a base unit or a central authorization server.

• Arias discloses a multi-function transaction processing system

• Meyer et al disclose a portable transaction terminal for processing credit card transactions.

• Albert et al disclose a wireless adaptor and wireless financial transaction system

9.     Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447.  The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

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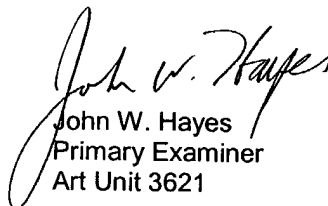
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>              "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

John W. Hayes
Primary Examiner
Art Unit 3621

June 23, 2004